REMARKS

[0003]   Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-36 are presently pending. Claims amended herein are 1, 14, 21, 23 and 30. Claims withdrawn or cancelled herein are none. New claims added herein are none.

Statement of Substance of Interview

[0004]   The Examiner graciously talked with me—the undersigned representative for the Applicant—on March 19, 2009. Applicant greatly appreciates the Examiner's willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

[0005]   During the interview, I discussed how the claims differed from the cited references, namely Challapali and Hyon. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments.

[0006]   The Examiner indicated that the § 101 rejections would be withdrawn and the proposed amended claims distinguish from the cited references. However, the Examiner indicated that he would need to review the cited art more carefully or do another search, and requested that the proposed amendments be presented in writing.

[0007]   Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited art of record for at least the reasons discussed during the interview.

Claim Amendments

[0008]   Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 14, 21, 23 and 30 herein. Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to the cited references. Support for the amendments to claims 1, 14, 21, 23 and 30 is found in the specification at least at pages 5-16.

Substantive Matters

Claim Rejections under § 101

[0009]   Claims 1-29 are rejected under 35 U.S.C. § 101.   Applicant respectfully traverses this rejection. Applicant herein submits that that the claims of the instant Application are to be construed—now and in the future--to be limited to subject matter deemed patentable in accordance with section 101 of Title 35 U.S.C., and as interpreted by appropriate and authoritative Article III entities.   In light of this disclaimer, Applicant asserts that these claims are allowable.   Accordingly, Applicant asks the Examiner to withdraw these rejections.

[0010]   If the Examiner maintains the rejection of these claims, then Applicant requests additional guidance as to what is necessary to overcome the rejection.

Claim Rejections under § 103

[0011]   Claims 1-36 are rejected under 35 U.S.C. § 103.   In light of the amendments presented herein and the agreements reached during the above-discussed Examiner interview, Applicant submits that these rejections are moot. More specifically, in the amended claims, a single set of pixels is selected as an emoticon, and both of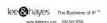 text message and the emoticon are displayed on a screen. These features are not disclosed in the cited references.   Accordingly, Applicant asks the Examiner to withdraw these rejections.

[0012]   The Examiner's rejections are based upon the following references in combination:

- **Challapali:** *Challapali,* US Patent Application Publication No. 2002/0194006 (Published December 19, 2002);

- **Hyon:** *Hyon,* US Patent Application Publication No. 2002/0077135 (Published June 20, 2002);

- **AllAlias:** *AllAlias.com; MUST READ; Signature/Avatar Rules,* Updated 5-23-03; 9/6/03; AllAlias.com

- **Chodor:** *Chodor, et al.,* US Patent Application Publication No. 2002/0036990 (Published March 28, 2002);

- **Hickman:** *Hickman, et al.,* US Patent No. 7,013,327 (issued March 14, 2006);

- **Dawson:** *Dawson,* US Patent No. 6,252,588 (issued June 26, 2001);

- **Day:** *Day, et al.,* US Patent Application Publication No. 2005/0027839 (Published February 3, 2005);

- **Jilk JR:** *Jilk JR, et al.,* US Patent Application Publication No. 2002/0010746 (Published January 24, 2002);

- **Goodwin III:** *Goodwin III, et al.,* US Patent Application Publication No. 2002/0065931 (Published May 30, 2002);

- **Goldschneider:** *Goldschneider, et al.,* US Patent Application Publication No. 2002/0107925 (Published August 8, 2002);

- **Huntington:** *Huntington, et al.,* US Patent Application Publication No. 2003/0131098 (Published July 10, 2003); and

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- **Zhao:** *Zhao, et al.,* US Patent No. 7,353,253 (issued April 1, 2008).

Overview of the Application

[0013]   The Application describes a technology for creating and transferring custom emoticons which allow a user to adopt an arbitrary image as an emoticon.

Cited References

[0014]   The Examiner cites Challapali as the primary reference in the obviousness-based rejections. The Examiner cites Hyon as secondary references in the obviousness-based rejections.

Challapali

[0015]   Challapali is directed to a visual speech system for converting emoticons into facial expressions on a displayable animated facial image.

Hyon

[0016]   Hyon is directed to a method of easily inputting icons representing user emotions. A plurality of emoticons, formed by utilizing a plurality of typical characters and special characters in combination, are grouped and stored by groups in the mobile terminal.

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Obviousness Rejections

Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)

[0017]   Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

Based upon Challapali

[0018]   The Examiner rejects claims 1-36 under 35 U.S.C. § 103(a). The Examiner cites Challapali as the primary reference in the obviousness-based rejections. The Examiner cites Hyon as secondary references in the obviousness-based rejections. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims.

Independent Claim 1

[0019]   Applicant submits that the cited references do not anticipate or make obvious at least the following features as recited in this claim (with emphasis added):

- **creating an emoticon by a sender** by selecting a **single** set of pixels to be used as an emoticon;

- **assigning** a character sequence to the pixels **by the sender**;

- wherein the emoticon is to be **substituted within the text message for the character sequence within the text message**;

- both of **text message** and the **emoticon** are displayed on a screen;

- establishing a **real-time peer-to-peer** link between the sender and the destination to retrieve the pixels from a storage medium associated with the sender.

[0020]   In contrast, Challapali is directed to a **text to visual speech** technology (see Title of Challapali), where a user receives a video speech broadcast containing the message (see Paragraph [0020] of Challapali).   In Challapali, **the emoticon itself is converted into** a facial expression (see Abstract of Challapali), which is almost the opposite of the claimed feature of the Application, where the character sequence is <u>substituted</u> **into an emoticon** <u>within</u> **the text message**. Furthermore, as shown in the figures of Challapali, Challapali receives texts as commands to change the facial expression of **another** image, which is different from the claimed feature that the emoticon is to be **substituted within the text message for the character sequence within the text message**.   In Challapali, no character sequence is <u>substituted</u> <u>within</u> the text message.

[0021]   Also, in the amended claim, a **single** set of pixels is selected as an emoticon.   However, in Challapali, the facial expression keeps talking and changing, and no **single** set of pixels is selected as an emoticon.   Moreover, since Challapali uses a text-to-visual technology, not both of **text message** and the **emoticon** are displayed on a screen.

[0022]   Hyon is relied upon as a secondary reference. However, in Hyon also, no character sequence is **substituted** **within** the text message. Actually, in Hyon, no character sequence is input at all by a keyboard device as an emoticon. An emoticon is selected by scrolling into different screens (see Fig. 4 of Hyon).

Independent Claims 14, 21, 23, and 30

[0023]   During the interview, the Examiner indicated that similar amendments (by adding single set of pixels, and both of text message and the emoticon are displayed on a screen) would make the amended claims distinguish from the cited references. Accordingly, Applicant asks the Examiner to withdraw these rejections of these claims.

Dependent Claims 2-13, 15-20, 22, 24-29, and 31-36

[0024]   These claims ultimately depend upon independent claims 1, 14, 21, 23 or 30. As discussed above, claims 1, 14, 21, 23 and 30 are allowable.   It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable.   Additionally, some or all of these claims may also be allowable for additional independent reasons.

Conclusion

[0025]   All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application.   If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action**. Please call or email me at your convenience.

Respectfully Submitted,

Lee & Hayes, PLLC
Representatives for Applicant

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